

U.S. Application No. 09/937,163  
Response to Office Action Mailed November 26, 2003

### REMARKS

Claims 16 – 31 were pending in the present application. Claims 16, 29, and 31 have been amended in the present amendment. Claims 16 – 31 remain pending in the present application. The Applicant respectfully requests further examination of the application in light of the accompanying remarks.

#### Rejection of Claims 16 - 29, and 31 Under 35 U.S.C. 112

Claims 16 – 29 and 31 were rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims were rejected for the use of the term “non-rotating mandrel.” Claims 16, 29, and 31 have been amended to remove the term “non-rotating mandrel.”

Claim 31 was rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. More particularly, the use of the phrases “the region of a pocket” and “pocket conveyor” was deemed vague and indefinite. As a result, claim 31 has been amended to describe the package sleeve as being in the region of a cell of a conveyor, rather than a pocket of a pocket conveyor. Support for this amended claim can be found at Page 6, Paragraph 3 of the Specification, wherein a plurality of cells in an endless chain are described as conveying a package through various stations along the chain. This conveyor is portrayed as element 11 in Figures 2, 3, and 5 of the present application.

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As a result of the amended pertinent portions of claims 16, 29, and 31, the Applicant kindly asserts that the rejections under 35 U.S.C. 112 are moot.

Rejection of Claims 16, 17, 27, and 28 under 35 U.S.C. 102(b)

The Examiner has rejected claims 16, 17, 27, and 28 under 35 U.S.C. §102(b) as being anticipated by Nakajima (U.S. Patent No. 4,516,382). The rejection is respectfully traversed.

The Applicant respectfully asserts that Nakajima does not disclose all of the elements of the claimed present invention. For example, Nakajima does not claim the step of conveying the package sleeve onto a mandrel of a mandrel wheel upstream from a filling machine so that the opening in the package sleeve is oriented outward. This element has been added to the amended claims 16, 29, and 31 of the present application. Despite the clear teaching of Nakajima to describe the various stations for folding and sealing to form and fill a carton, Nakajima does not provide any teaching to indicate that the opening in the package sleeve would be oriented outward for the application of a tear-off strip as claimed in the present application. As shown in Figs. 3 – 5 of Nakajima, the mandrels (8) do not rotate (except as a group in the axial rotation of the disc (6)). As shown at Fig. 5 and with greater detail at Fig. 6 of Nakajima, the cartons do not have an opening (sealed or unsealed as shown in Fig. 1) oriented outward during the cartons' conveyance on the mandrels (8) of the disc (6). In contrast, the Applicant specifically claims as an inventive step in the amended method claims of the present invention the conveyance of the package sleeve onto a

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mandrel of a mandrel wheel upstream from a filling machine so that the opening in the package sleeve is oriented outward.

At least in this regard, the Applicant contends that Nakajima does not disclose every element and limitation of the claimed present invention. As a result, the Applicant respectfully asserts that the outstanding rejections of claims 16, 17, 27, and 28 may be properly withdrawn.

Rejection of Claims 21, 22, 24, and 25 under 35 U.S.C. 103(a)

The Examiner has rejected claims 21, 22, 24, and 25 under 35 U.S.C. §103(a) as being unpatentable over Nakajima (U.S. Patent No. 4,516,382) in view of Watanabe (U.S. Patent No. 4,986,859). The rejection is respectfully traversed.

The Applicant respectfully asserts that Nakajima in view of Watanabe does not disclose all of the elements of the claimed present invention. As discussed above, neither Nakajima nor Watanabe discuss the step of conveying the package sleeve onto a mandrel of a mandrel wheel upstream from a filling machine so that the opening in the package sleeve is oriented outward. At least in this regard, the Applicant respectfully asserts that Nakajima in view of Watanabe would not render the claimed present invention as obvious. As a result, the Applicant respectfully asserts that the outstanding rejections of claims 21, 22, 24, and 25 may be properly withdrawn.

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Rejection of Claims 20, 23, and 26 under 35 U.S.C. 103(a)

The Examiner has rejected claims 20, 23, and 26 under 35 U.S.C. §103(a) as being unpatentable over Nakajima (U.S. Patent No. 4,516,382). The rejection is respectfully traversed.

The Applicant respectfully asserts that Nakajima does not disclose all of the elements of the claimed present invention. As discussed above, Nakajima does not discuss the step of conveying the package sleeve onto a mandrel of a mandrel wheel upstream from a filling machine so that the opening in the package sleeve is oriented outward. At least in this regard, the Applicant respectfully asserts that Nakajima would not render the claimed present invention as obvious. As a result, the Applicant respectfully asserts that the outstanding rejections of claims 20, 23, and 26 may be properly withdrawn.

Allowable Subject Matter

The Examiner has indicated that claim 30 is allowable. The Applicant appreciates the Examiner's acknowledgment of allowable subject matter. If any progress on the present application can be assisted by the Applicant before the close of prosecution, the Examiner is kindly encouraged to contact the Applicant at their convenience.

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### CONCLUSION

Claims 16 – 31 are pending in the present application. Claims 16, 29, and 31 have been amended in the present amendment. The Applicant respectfully requests further examination of the application in light of the accompanying remarks.

Respectfully submitted,

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